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Supreme Court, U.S.
FILED
AUG 15 2002
OFFICE OF THE CLERK

No. 01-1849

IN THE

Supreme Court of the United States

INFINITE PICTURES, INC.

Petitioner,

v.

INTERACTIVE PICTURES CORPORATION
(formerly known as Omniview, Inc.)

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY TO BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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August 15, 2002

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Petitioner has requested a writ of certiorari to address the unresolved conflict between the judicial doctrine of equivalents and the congressionally-mandated equivalents analysis of 35 U.S.C. § 112(6), with respect to functionally-claimed elements. The doctrine of equivalents should not apply to elements whose construction has been mandated by statute. Even if applicable, however, those claim elements should not be construed in a way that nullifies the statutory interpretation command.

I. The Issue of Whether or not the Doctrine of Equivalents Should Apply to Elements Drafted to Invoke § 112(6) was Decided by the Court of Appeals for the Federal Circuit but has not been Addressed by this Court.

Respondent contends that the issue of whether the doctrine of equivalents can apply to § 112(6) elements was not addressed or decided by the Federal Circuit. Contrary to that contention, this is not an unrelated or tangential issue that is beyond the reach of this Court. Rather, neither the District Court nor the Federal Circuit could have reached their decisions without deciding this issue. Relying solely on *WMS Gaming, Inc. v. Int'l Gaming Tech.*, 184 F.3d 1339 (Fed. Cir. 1999), the Federal Circuit expressly held that the doctrine of equivalents could be applied where there was no infringement under 35 U.S.C. § 112(6). *See, e.g.*, Brief in Opposition to Petition for Writ of Certiorari (Opposition) p. 10. That holding is the subject of this appeal.

In any event, it should be noted that Petitioner, in its opening brief to the Federal Circuit, challenged the application of the doctrine of equivalents to this § 112(6) claim element. After explaining the proper construction procedure for § 112(6) limitations, Petitioner argued in Appellant's brief at page 30 that "IPIX tried to short-circuit this statutory analysis by resorting to the doctrine of equivalents."

A. The Federal Circuit's Application of the Doctrine of Equivalents to a § 112(6) Element Presupposes that the Doctrine can be Properly Applied to Such Elements.

The Federal Circuit could not have upheld the infringement finding under the doctrine of equivalents without first concluding (or simply presupposing) that the doctrine could be applied to a § 112(6) claim element. The Federal Circuit, in fact, assumed that

the doctrine of equivalents could apply to a claim element drafted to invoke § 112(6), but failed to adequately consider or address the inherent conflict in applying both equivalents analyses to a single functional claim limitation.

The only case prior to this one that affirmed a determination of infringement under the doctrine of equivalents where the means-plus-function element at issue was not met literally under § 112(6) was *WMS Gaming*. At least in *WMS Gaming*, however, the Court first undertook a structural equivalents analysis under § 112(6) to determine a range of equivalent structure before beginning its doctrine of equivalents analysis with respect to the function. 184 F.3d at 1348-51.

Respondent further contends that the Federal Circuit's denial of the petition for rehearing *en banc* both shows that it "declined to entertain [a] new issue" and also "indicates that there is no doubt on [the issue of whether the doctrine of equivalents can apply to § 112(6) elements]." Opposition pp. 4, 14. These conflicting arguments suggest that the Court decided this issue on the merits while declining to even consider it. The opinionless denial of the petition for rehearing *en banc*, however, cannot be interpreted as supporting either contention. The reason for the denial of rehearing is not discernible.

B. If Application of the Doctrine of Equivalents to Functionally-claimed Elements Invoking § 112(6) is Precluded by Statute, Neither the District Court nor the Fed. Circuit had the Authority to Impose Liability.

Congress has the controlling authority to legislate on patent matters under Article I, § 8, cl. 8 of the Constitution. Congress has exercised that power through § 112(6) – the only provision in the patent

statute directing a claim construction methodology. Application of the doctrine of equivalents to § 112(6) claim elements abrogates the statutory claim construction requirements and violates the public-notice and definitional requirements of patent claiming.

If, therefore, as Petitioner contends, Congress has established § 112(6) as the exclusive mechanism for the interpretation of functionally-stated claim elements, then neither the District Court nor the Federal Circuit has the authority to bypass those statutory requirements through application of the doctrine of equivalents. The Court should hear this case to resolve this conflict between the legislative and judicial branches of government.

Contrary to Respondent's position, this is not the same as the issue presented to this Court in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997). In *Warner-Jenkinson*, the Court concluded that the enactment of § 112(6) did not *replace* the doctrine of equivalents. *Warner-Jenkinson*, however, did not deal with a § 112(6) claim element and the Court therefore did not address the relationship between the two "equivalents" approaches when both forms of equivalents are implicated. *See* 520 U.S. at 28. The Court, in particular, did not address which approach would trump when both approaches were applied to a single claim element.

II. Even if the Doctrine of Equivalents can be Applied to § 112(6) Claim Elements, it Cannot be Used to Completely Untether the Claim from its Statutorily-Mandated Construction.

The trial court in effect construed the "image transform processor means" under the doctrine of equivalents instead of under § 112(6). This approach, affirmed by the Federal Circuit, enabled infringement to be found even though the accused structure and its

function differ substantially from those described and claimed in the patent.

A. The Decision Below Permits an Infringement Finding With Respect to a Functional Claim Element Without a § 112(6) Structural Equivalents Analysis.

For microprocessor and computer elements, such as the image transform processor means, the structure is not merely the general-purpose computer or microprocessor but, rather, the computer or processor programmed to perform the disclosed algorithm. *See, e.g., WMS Gaming*, 184 F.3d at 1348-51; *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) *(en banc)*. The identification of the disclosed algorithm is an essential part of determining the proper scope of such claim elements. *See id.*

Respondent's sweeping assertion that the structure corresponding to "the image transform processor means was not limited to a specific mathematical algorithm, but instead encompassed a range of lens types and corresponding algorithms" (Opposition p. 15) illustrates precisely the error in the Respondent's reasoning and that of the Court below. Irrespective of the expansive patent boilerplate cited by Respondent, the image transform processor means of claim 1 is expressly limited to processing digitized fisheye images from a hemispherical fisheye lens.[1] The corresponding structure, therefore, must be the algorithm disclosed in the specification for performing that function, not

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[1] Claim 1, by its express terms, requires a *fisheye lens* that produces optical images corresponding to a *hemispherical* field-of-view, for which the precise algorithm is set forth in the specification (col. 5 through col. 7) as well as dependant claim 9, which Respondent did not assert as being infringed. *See* Petition App. 5a.

some other algorithm that is not even described in the patent.

Respondent's position would completely eliminate the requirement to look to the corresponding structure for performing the recited function, and would permit any structure to satisfy the claim limitation as long as the function was equivalent. Using this approach, it therefore becomes impossible to follow the construction guidelines of § 112(6) because the function is no longer tied to the recited function, but, rather, could be any arguably "equivalent" function with a corresponding structure not even expressly disclosed or described in the patent specification.

This approach, implicitly affirmed by the Federal Circuit, therefore improperly relieves the patentee of the burden of showing structural equivalence separate and apart from functional equivalence. Patentees who argue the doctrine of equivalents are therefore allowed to bypass the statutory structural equivalents analysis of § 112(6) for those claim elements.

B. The Decision Below Allows Application of the Doctrine of Equivalents to Entirely Vitiate a Required Function of the Claim.

In both *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (*en banc*) and in this case, specific limitations of a means-plus-function element are not present in the accused device. In *Pennwalt*, those differences formed the core of the Federal Circuit's determination of non-infringement. Respondent's attempt to distinguish *Pennwalt* on this point is flagrant sophistry. *See* Opposition p. 17.

In this case, as claimed, the "image transform processor means" expressly requires transformation "according to a combination of said digitized [fisheye] signals, said selected viewing angles and said selected magnification." Petition App. 5a. Regardless of

whether the phrase "direct transformation" appears in the claims, the very nature of these combined inputs dictates that the claimed transformation is direct. The selected viewing angles and magnification are combined with the digitized fisheye signals to produce the perspective-corrected view.

As acknowledged in the Respondent's exhibits, the accused device does not use this claimed combination of signals. Petition App. 56a. In Petitioner's product, rather, the entire fisheye image must first be converted into an equirectangular image using a first transform, which is independent of any selected view and magnification. Only then can a second transform be used, along with a selected viewing area and magnification, to produce the perspective-corrected image. *See id.*

As in *Pennwalt*, therefore, the accused device in this case lacks a means operative in response to the specified (and claimed) combination of signals. By permitting a finding of infringement, the lower courts permitted the function of transforming "according to the combination" of the claimed signals to be vitiated in its entirety.

This approach is contrary to the directive of this Court in *Warner-Jenkinson*:

> Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole. It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.

520 U.S. at 29.

CONCLUSION

The Court should take this case to declare that the doctrine of equivalents is inapplicable to § 112(6) elements because it runs afoul of the statutory limits on functional claiming. The Court must enunciate standards to ensure that the application of the judicial doctrine does not eviscerate the statutorily-mandated construction requirements of § 112(6) or the requirements of the all-elements rule as applied to those claim elements.

Accordingly, the Court should grant the petition for a writ of certiorari.

Respectfully submitted,

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